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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/777,260
Filing Date: February 12, 2004
Appellant(s): GARBOW, ZACHARY ADAM

Zachary A. Garbow
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12 August 2009 appealing from the Office action mailed 12 March 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2004/0,019,724 A1	SINGLETON JR. et al.	01-2004
2003/0,065,734 A1	RAMAKESAVAN	04-2003
6,667,877 B2	DUQUETTE	12-2003
2004/0,148,419	CHEN et al.	07-2004

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6,957,397	HAWKINS et al.	10-2005
7,197,584 B2	HUBER et al.	03-2007

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
2. Claims 1, 4, 6, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singleton, Jr. et al. (2004/0019724) in view of Ramakesavan (2003/0065734) and Duquette (6,667,877).
3. For claim 1, Singleton teaches a method (abstract; Paras. 1-11, 34-35) comprising:
 - a. determining whether data meets a criteria (Paras. 24-27, 31-33);
 - b. if the data does not meet the criteria, sending the data to a computer display of a computer (Paras. 24-27, 31-33), wherein the computer comprises a base portion and a lid portion, wherein the base portion and the lid portion of the computer are attached via a first hinge, wherein the base portion and the lid portion of the computer rotate via the first hinge between a first closed position

- and a first open position, and wherein the lid portion comprises the computer display (Paras. 11-16, 19-21); and
- c. if the data meets the criteria, sending the data to a personal digital assistant (Paras. 24-27, 31-33) attached to the laptop (Paras. 11-16, 19-21), wherein in the second open position a screen of the personal digital assistant is viewable simultaneously with the computer display when the base portion and the lid portion of the computer are in the first open position, and wherein in the second closed position the screen of the personal digital assistant is not viewable simultaneously with the computer display (Fig. 1).
4. Singleton does not expressly disclose that the PDA shifts between a second closed position atop the lid portion of the computer and an a second open position side-by-side with the lid portion of the computer. Ramakesavan teaches a method (abstract) of connecting (Paras. 1-24; 39-40) a PDA to a laptop (Figs. 4-7) wherein the PDA may be placed side by side with the monitor or otherwise shifted into the lid (Paras. 32-34). At the time the invention was made, one of ordinary skill in the art would have added Ramakesvan to Singleton in order to speed up the synchronization process (Para. 6)
5. Singleton does not expressly disclose that the PDA is detachably and rotatably connected to the lid portion of the computer via a second hinge, wherein the personal digital assistant rotates via the second hinge between the open and closed positions. Duquette teaches a method (abstract) of adding a synchronized device as a secondary display (col. 1, line 1 - col. 5, line 5; col. 6, lines 15 - 25) wherein the secondary system is detachably and rotatably connected to the laptop lid via a hinge such that it may rotate side by side or atop the lid (col. 5, line 5 - col. 6, line 15). At the time the invention was

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made, one of ordinary skill would have added Duquette to Singleton in order to provide better storage for PDA monitors (col. 4, lines 5 - 50).

6. For claim 4, Singleton teaches determining whether the data comprises a calendar application window (Para. 18).

7. For claim 6, Singleton teaches determining whether the data comprises an e-mail application window (Para. 18).

8. For claim 23, Singleton does not expressly disclose sending input from an input device in the base portion to the personal digital assistant. Ramakesavan teaches integrating the laptop and PDA (Paras. 23 – 26) such that inputs from the laptop are sent to the PDA (Paras. 27 – 36).

9. Claims 2, 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Singleton, Ramakesavan and Duquette as applied to claim 1 above, and further in view of Chen et al. (2004/0148419).

10. For claim 2, Singleton does not expressly disclose determining whether the data comprises an instant messaging application window. Chen teaches the usage of IM applications (Paras. 81, 110, 191). At the time the invention was made, one of ordinary skill in the art would have added Chen to Singleton in order to improve the functionality of the PDA devices (Paras. 9 – 13).

11. For claim 5, Singleton does not expressly disclose determining whether the data comprises a media player application window. Chen teaches this limitation as well (Paras. 81, 110, 191).

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12. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Singleton, Ramakesavan and Duquette as applied to claim 1 above, and further in view of Hawkins et al. (6,957,397).

13. For claim 3, Singleton does not expressly disclose determining whether the data comprises a calculator application window. Hawkins teaches the usage of calendar information (col. 3, lines 15 – 25). At the time the invention was made, one of ordinary skill in the art would have added Hawkins to improve PDA functionality (col. 1, lines 40 – 65).

14. Claims 21, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singleton, Ramakesavan and Duquette as applied to claim 1 above, and further in view of Huber et al. (7,197,584).

15. For claim 21, Singleton does not expressly disclose instructing a power supply of the computer to supply power to an input device of the computer, and receiving input at the personal digital assistant from the input device of the computer. Huber teaches a method (abstract) of attaching a PDA to a laptop lid (Fig. 6; col. 3, line 50 – col. 4, line 45) wherein a laptop's input device (keyboard) is tied to the power supply and wherein the PDA is controlled by the laptop (Fig. 5; col. 4, line 45 – col. 5, line 45). At the time the invention was made, one of ordinary skill in the art would have made the combination for power management purposes (col. 2, lines 30 -55).

16. For claim 22, Singleton does not expressly disclose determining that data has been changed at the personal digital assistant, determining whether the computer is powered on, and if the data has been changed at the personal digital assistant and the

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computer is powered on, synchronizing the data with the computer. Huber teaches this limitation (Fig. 5; col. 4, line 45 – col. 5, line 45; coordinated memory).

(10) Response to Argument

Applicant argues that the combination of Singleton, Ramakesavan and Duquette does not expressly disclose that the PDA is “detachably and rotatably connected to the lid portion of the computer via a second hinge, wherein the personal digital assistant rotates via the second hinge between a second closed position atop the lid portion of the computer and a second open position side by side with the lid portion of the computer... wherein in the second closed position the screen of the personal digital assistant is not viewable simultaneously with the computer display (Pp. 16 - 22).” Applicant and examiner are in agreement that the terms are to be interpreted broadly, i.e. the PDA screen may or not be viewable in the closed position (P. 19, Para. 4).

One must give the claims their broadest reasonable interpretation in light of the knowledge of one of ordinary skill in the art and in light of the specification. One must also review the art as a whole, and consider structural and functional similarities.

Singleton teaches a connection between a PDA and a laptop such that neither screen is viewable in the closed position (Fig. 1). While not attached to the lid, it may still be considered to rotate along a hinge in an absolute Newtonian sense, albeit along the single hinge connecting the lid and the base.

Ramakesavan teaches a connection between a PDA and a laptop (Fig. 4) such that the lid and the PDA are side by side along a second axis (the base/lid connection being the first axis), but may be detached from that axis (Fig. 7). As conceded by the applicant (P. 17, Para. 3, continued on P. 18), Ramakesavan also teaches that the screen of the PDA rotates with the lid of the PDA along a hinge such that the lid and screen may be side by side (Fig. 5A), but the screen is rotatable along the hinge to be closed atop the lid portion (Fig. 5B). Ramakesavan does not say one way or the other whether the PDA, when attached to the monitor, is rotatable or stationary along that secondary axis (Para. 33), but one of ordinary skill in the art would begin to see some advantages of rotatability in light of the variety of cited teachings as a whole.

Duquette teaches a connection between a laptop lid and a detachable second monitor (Fig. 2) capable of rotation along the secondary axis (Figs. 1-4) such that the two screens may be side by side or bent back behind the lid, and such that the monitors may or may not be seen simultaneously (col. 5, line 10 – col. 6, line 15). Duquette further teaches that “the invention may be a simple dumb monitor or may be made as a laptop with dual screens with extended visual use with one or more application software programs as would be easily facilitated by those of skill (col. 5, lines 45 – 55).” One of ordinary skill in the art would recognize that the monitor might be a smart monitor, i.e. a PDA. The particular monitor is not at issue, however, because one who sees both Ramakesavan and Duquette would be motivated to add Duquette’s housing, not Duquette’s second monitor, to Ramakesavan.

Huber teaches the connection of the PDA to the base (Fig. 1, Fig. 6, #110) or the lid (Fig. 6, #615). If attached to the lid, it will clearly rotate along the primary axis

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(base/lid connection) such that the screens are not simultaneously viewable in the closed position. Such art is not required for the current rejection, but provides further teachings that one of ordinary skill in the art would be motivated to make this combination.

The motivations are obvious. One of ordinary skill in the art would recognize that moving the PDA in Singleton from the base to the lid, side by side like in Ramakesavan, would provide better viewing and would allow Singleton to better use the PDA as a second monitor. One would then use a second hinge, a la Duquette, in Ramakesavan's side by side system, either to allow for better protection of the screen (Duquette's motivation) or to allow an option where one may use the PDA to control the laptop even when the laptop is closed (Huber's motivation).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is that of the items above. There is also motivation to combine in that they improve synchronization among the components, i.e. (Ramakesavan, Para. 6).

In the alternative, the combination is allowable under *KSR International v. Teleflex, Inc.*, 127 S.Ct. 1727 (2007). The combination claimed by the applicant is one of a combination of familiar elements by known methods yielding predictable results.

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There are only a limited number of ways to connect a PDA to a laptop, both in location and in connections, and one of ordinary skill in the art and ordinary common sense would have, in light of the cited art, found this particular combination at least obvious to try.

See also *In re Paulsen*, 30 F.3d 1475 (Fed. Cir. 1994) (stating that one may find as obvious a laptop hinge from a variety of different hinges, even those not in the computer or mechanical arts, regardless of orientation, rotation or similarity of hinge).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the art teaches away from combination, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Applicant argues that Singleton teaches away from combination because it teaches a PDA attached to the base (P. 17, Para. 1). This does not foreclose modifications to the art wherein the PDA may be attached to the lid. In fact, it teaches towards the combination because the motivation behind attaching the PDA to the base, near the keyboard, is to allow a user to view and access both screens, and neither is frustrated by adding the PDA to the lid.

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Applicant argues that the fact that Ramakesavan does not expressly disclose rotation around the necessary axis automatically means that Ramakesavan teaches away from rotation along the secondary axis (P. 17, Para. 2). This in particular shows applicant's piecemeal analysis; applicant is attacking one piece of art without considering other pieces of art, let alone any motivation to combine. As shown before, Ramakesavan is silent as to whether or not there may be motivation to rotate along this axis. But even if Ramakesavan expressly stated a clear preference for stationary connections between the monitor and PDA, this does not mean that one of ordinary skill in the art would not see motivation to change to a rotation connection, nor that such a change would wreck Ramakesavan.

Applicant then argues that the PDA's clamshell design teaches away from the combination (P. 17, Para. 3). Examiner cannot determine how this factor teaches away from rotation along the second axis, and applicant does not further elaborate. It seems to the examiner that Figs. 5A and 5B are silent as to the issue. However, they may be construed as teaching towards combination because one of ordinary skill in the art, seeing this act of rotation, might find adding similar rotation to Ramakesavan to be obvious to try.

Finally, applicant argues that Duquette would destroy Ramakesavan because we would have to replace the PDA with a second monitor (P. 18, Para. 1). This is a questionable interpretation of the combination and the act of combining under 103, and further points to the applicant's piecemeal analysis. Examiner is not replacing a PDA with a second monitor, nor is he replacing the entire Ramakesavan system with the Duquette system. Instead, he is replacing the unspecified connection between

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Ramakesavan's monitor and PDA with the housing and hinge-based connection of Duquette. In the alternative, the examiner may also replace Duquette's smart monitor with an even smarter monitor, i.e. a PDA or at least a touch screen with software.

Applicant is correct that he may raise evidence of teaching away (P. 18, Para. 3 – P. 19, Para. 3), but teaching away is not shown by mere attacks on individual references, nor by showing that a piece of art is missing a limitation, nor by merely showing that a piece of art happened to choose one solution over another. At no time does the applicant argue even a basic showing that the art considered and rejected any particular limitation, and his argument against bodily incorporation incorrectly assumes that every element of secondary art must be imported into the primary art.

Therefore, the court is urged to reject the applicant's arguments and affirm the examiner's ruling that the claims are properly rejected under the 103 arguments provided.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Melvin H. Pollack

/Melvin H Pollack/

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